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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Customer No. 23643

Group: 3752

Confirmation No.: 6528

Application No.: 10/016,596

Invention: METHOD AND APPARATUS FOR  
ADJUSTING AND POSITIONING  
AIR CAPS

Inventor: Baltz et al.

Filed: October 30, 2001

Attorney  
Docket: 3030-67663

Examiner: Davis D. Hwu

Certificate Under 37 CFR 1.8(a)

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*May 16, 2005*  
*Kim Tyree*  
(Signature)

Kim Tyree

(Printed Name)

APPEAL BRIEF

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This appeal brief is submitted in triplicate in furtherance of the appeal taken March 16, 2005. The \$330 fee for filing an appeal brief has previously been paid in connection with the appeal brief filed September 9, 2004. The Commissioner is hereby authorized to charge the \$170 difference between the then-current \$330 fee for filing an appeal brief and the current \$500 fee for filing an appeal brief, as well as any other fees which may be necessary to constitute this a timely filed appeal brief, to Appellants' undersigned counsel's deposit account 10-0435, with reference to file number 3030-67663.

A duplicate copy of this authorization is enclosed for this purpose.

05/19/2005 MAHMED1 00000046 100435 10016596

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### REAL PARTY IN INTEREST

The real party in interest is Illinois Tool Works Inc., by virtue of an assignment recorded October 30, 2001 in the records of the Patent and Trademark Office on patent record reel 012384, beginning at frame 0926.

### RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

### STATUS OF CLAIMS

Claims 1-19 are in this application. Of these, claims 1, 4, 5, 9, 10, 13, 16 and 17 have been twice rejected. The Examiner indicated that claims 2, 3, 6-8, 11, 12, 14, 15, 18 and 19 contained allowable subject matter, and would be allowed if rewritten in independent form including all of the limitations of their respective base claims and any intervening claims. The rejections of claims 1, 4, 5, 9, 10, 13, 16 and 17 are appealed.

### STATUS OF AMENDMENTS

No amendments were filed subsequent to the rejection from which this appeal is taken.

### SUMMARY OF THE CLAIMED SUBJECT MATTER

The invention may best be understood by referring to the following copies of appealed claims 1, 4, 5, 9, 10, 13, 16 and 17, annotated with parenthetical reference numbers and related notes from the detailed description.

With reference to claim 1, the invention is a device (10) for positioning an air cap (12) of a pneumatically aided atomizer (14), the air cap (12) having air horns (16) extending therefrom, the device (10) providing at least one first opening (56 or 58) adapted to receive the horns (16) and a first level (50 or 52) for indicating when the horns (16) received in the at least one first opening (56 or 58) are in a first orientation (with level 50 or 52 indicating level).

With reference to claim 4, the invention is the device (10) of claim 1 including a first surface (40) extending (sic--facing) generally in a first direction when the horns (16) are received in the at least one first opening (56 or 58) and a second surface (42) extending (sic--facing) generally in a second direction opposite the first direction when the horns (16) are received in the at least one first opening (56 or 58).

With reference to claim 5, the invention is the device (10) of claim 4 wherein the at least one first opening (56 or 58) extends through the device (10) from the first surface (40) to the second surface (42).

With reference to claim 9, the invention is the device (10) of claim 1 wherein the first level (50 or 52) for indicating when the horns (16) received in the at least one first opening (56 or 58) are in the first orientation is a first level (50 or 52) for indicating when the horns (16) received in the at least one first opening (56 or 58) are in a vertical orientation (with level 50 or 52 indicating level).

With reference to claim 10, the invention is the device (10) of claim 1 wherein the first level (50 or 52) for indicating when the horns (16) received in the at least one first opening (56 or 58) are in the first orientation is a first level (50 or 52) for indicating when the horns (16) received in the at least one first opening (56 or 58) are in a horizontal orientation (with level 50 or 52 indicating level).

With reference to claim 13, the invention is a method of positioning an air cap (12) of a pneumatically aided atomizer (14), the air cap (12) having air horns (16) extending therefrom, the method including providing a device (10) having at least one first opening (56 or 58) adapted to receive the horns (16) and a first level (50 or 52) for indicating when the horns (16) received in the at least one first opening (56 or 58) are in a first orientation (with level 50 or 52 indicating level).

With reference to claim 16, the invention is the method of claim 13 wherein providing a device (10) having at least one first opening (56 or 58) adapted to receive the horns (16) and a first level (50 or 52) for indicating when the horns (16) received in the at least one first opening (56 or 58) are in a first orientation includes providing a device (10) having a first surface (40) extending (sic--facing) generally in a first direction when the horns (16) are received in the at least one first opening (56 or 58) and a second surface (42) extending (sic--facing) generally in a second direction opposite the first direction when the horns (16) are received in the at least one first opening (56 or 58).

With reference to claim 17, the invention is the method of claim 16 wherein providing a device (10) having at least one first opening (56 or 58), a first surface (40) extending (sic--facing) generally in a first direction when the horns (16) are received in the at least one first opening (56 or 58) and a second surface (42) extending (sic--facing) generally in a second direction opposite the first direction when the horns (16) are received in the at least one first opening (56 or 58) together include providing at least one first opening (56 or 58) which extends through the device (10) from the first surface (40) to the second surface

(42).

#### GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The sole ground of rejection to be reviewed by the Board is whether claims 1, 4, 5, 9, 10, 13, 16 and 17 lack novelty under 35 U.S.C. § 102(b) as being anticipated by Jaccard U.S. Patent No. 4,908,949 (hereinafter Jaccard).

#### ARGUMENT

In the official action of December 16, 2004 the Examiner rejected claims 1, 4, 5, 9, 10, 13, 16, and 17 under 35 U. S. C. § 102(b) as anticipated by Jaccard.

The Examiner takes the position that

“Jaccard shows an apparatus providing at least one first opening and a first level 12 which indicates when a device received in the at least one first opening is in a first orientation (see Figure 2 attached herein). The device of Jaccard is fully capable of positioning an air cap of a pneumatically aided atomizer having air horns extending therefrom and indicating when the horns received in the at least one first opening are in a first orientation. The device of Jaccard includes a first surface extending generally in a first direction and a second surface extending generally in a second direction as recited in claim 4 (see Figure 2 attached herein) and wherein the at least one first opening extends through the device from the first surface to the second surface as recited in claim 5. Regarding claims 9 and 10, the first level will indicate when the device received in the at least one first opening is in a vertical orientation or a horizontal orientation since the apparatus of Jaccard can be oriented in vertical or horizontal orientations during usage. The device of Jaccard carries out the methods of claims 13, 16, and 17.”

The rejection, paragraph 5.

#### The Law of Anticipation

In accordance with longstanding precedent construing 35 U. S. C. § 102(b), anticipation of a claim requires a showing that a single prior art reference discloses each and every element and limitation of the claim. See, e.g., *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 20, 57 U.S.P.Q. 2d 1057 (Fed. Cir. 2000); *Electro Medical Systems, S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 1052, 32 U.S.P.Q.2d 1017 (Fed. Cir. 1994); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001 (Fed. Cir. 1991); *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1457, 221 USPQ 481, 485 (Fed. Cir. 1984); *In re King*, 801

F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986) (“The corollary of that rule is that absence from the reference of any claimed element negates anticipation.”). The Federal Circuit Court of Appeals strictly construes the requirement for a showing of anticipation under 35 U.S.C. § 102:

“[A]n invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim. The identical invention must be shown in as complete detail as is contained in the patent claim.”

*Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989) (citations omitted). Although the anticipatory reference “need not duplicate word for word what is in the claims” and “[a]nticipation can occur when a claimed limitation is ‘inherent’ or otherwise implicit in the relevant reference,” *Standard Havens Products, Inc. v Gencor Indus.*, 953 F.2d 1360, 1369, 21 U.S.P.Q.2d 1321 (Fed. Cir. 1991) (denial of stay of injunction and stay of damages proceedings on remand to District Court reversed by Federal Circuit in subsequent proceeding, 996 F.2d 1236, 27 U.S.P.Q.2d 1959 (Fed. Cir. 1993)), the Federal Circuit construes the “inherency” exception narrowly:

“Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

“This modest flexibility in the rule that ‘anticipation’ requires that every element of the claims appear in a single reference accommodates situations where the common knowledge of technologists is not recorded in the reference; that is, where technological facts are known to those in the field of the invention, albeit not known to judges. It is not, however, a substitute for determination of patentability in terms of § 103.”

*Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 U.S.P.Q.2d 1746 (Fed. Cir. 1991) (citing *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (quoting *Hansgirg v. Kemmer*, 102 F.2d 212, 214, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939)). Thus, a reference does not anticipate a claim if the claim contains any limitation that is neither literally nor inherently present in the reference.

### Analysis of Jaccard

Jaccard teaches an air-bubble level 12 for portable tools 10, such as dental handpieces. The air-bubble level 12 includes “a fork-shaped support 13, with which a body 14 designed to contain the liquid 15 and the relevant bubble of air, or of saturated vapour (sic) of liquid 16 is rotatably linked” See Jaccard, col. 2, lines 14-17. Jaccard provides, in pertinent part, that

“The purpose of the present invention is to provide an air-bubble level which can be used, and operates, independently from any changes in position of the tool, e.g., in handpiece or drill position, and which can be transferred between tools in an extremely simple way.” Jaccard, col. 1, lines 45-49.

Jaccard further teaches that the air-bubble level 12 includes “[a] bore 17, provided in the centre of the support 13, [ ] suitable for receiving with snap-engagement an elastic expandible appendix 18 which extends from the liquid-containing body 14.” See Jaccard, col. 2, lines 18-21.

### Claims 1, 4 and 5

Appellants’ claim 1 requires a device for positioning an air cap of a pneumatically aided atomizer, the air cap having air horns extending therefrom, the device providing at least one first opening adapted to receive the horns and a first level for indicating when the horns received in the at least one first opening are in a first orientation.

First of all, there is no disclosure or suggestion that the opening formed by the fork-shaped support 13 in Jaccard’s air-bubble level 12 is capable of receiving the horns of any air cap in any orientation. The fork-shaped support 13 of Jaccard’s air-bubble level 12 allows the level 12 to be snap-fitted onto the shank of a dental hand tool 10, as discussed in the specification of Jaccard. Thus, the opening created by the fork-shaped support 13 of Jaccard is not appropriately sized or “adapted to receive” the horns of an air cap as claimed in claim 1. Appellants cannot imagine any air cap, the horns of which the opening created by the fork-shaped support 13 of Jaccard is adapted to receive. Further, Jaccard provides no support, teaching, or suggestion that the opening created by the fork-shaped support 13 is capable of receiving or adapted to receive horns of an air cap.

Even assuming for the sake of argument, however, that the opening formed by the fork-shaped support 13 in Jaccard’s air-bubble level 12 would, in fact, be able to receive the horns of an air cap, that opening is C-shaped, and therefore would be able to receive the horns in any number of orientations. Indeed, the generally C-shaped opening formed by Jaccard’s fork-shaped support does not provide the user with any indication in which of an

infinite number of possible orientations the horns of the air cap should be received. As such, the opening formed by Jaccard's fork-shaped support 13 is not capable of distinguishing one orientation of the horns of such an air cap from another orientation of the horns of an air cap. Since the tool to which Jaccard's fork-shaped support 13 is to be attached presumably has a circular cross section, the opening in Jaccard's fork-shaped support 13 will not (and indeed is not intended to) so orient Jaccard's fork-shaped support 13 with respect to the horns of such an air cap that Jaccard's level will, in the words of claim 1, "indicat[e] when the horns received in the at least one first opening are in a first orientation." Even further, Jaccard's level 12 is rotatably attached 17, 18 to Jaccard's fork-shaped support 13 ("The provision of the coupling consisting of the bore 17 of the support 13, and the expandible appendix 18 makes it possible the position of the body 14 of the level 12 to be varied according to as required by the user, so as to secure that the perfect centering of the air bubble is always visible." Jaccard, col. 2, lines 38-43). Therefore, the level 12 of Jaccard is not intended to indicate a particular orientation of Jaccard's handpiece 10, but rather, only to indicate a particular orientation of Jaccard's level 12. Therefore, the 35 U. S. C. § 102(b) rejection of claim 1 based upon Jaccard is in error, and should be reversed.

Claims 4 and 5 stand or fall with claim 1.

#### Claim 9

Claim 9 recites a device for positioning an air cap of a pneumatically aided atomizer, the air cap having air horns extending therefrom, the device providing at least one first opening adapted to receive the horns and a first level for indicating when the horns received in the at least one first opening are in a vertical orientation.

Again, Jaccard's level 12 is rotatably attached 17, 18 to Jaccard's fork-shaped support 13 ("The provision of the coupling consisting of the bore 17 of the support 13, and the expandible appendix 18 makes it possible the position of the body 14 of the level 12 to be varied according to as required by the user, so as to secure that the perfect centering of the air bubble is always visible." Jaccard, col. 2, lines 38-43). Therefore, the level 12 of Jaccard is not intended to indicate a particular orientation of Jaccard's handpiece 10, but rather, only to indicate a particular orientation of Jaccard's level 12. Again, if, for the sake of argument, the opening in Jaccard's fork-shaped support 13 could receive the horns of an air cap, it would be able to receive the horns in any number of orientations. As such, the opening in Jaccard's fork-shaped support 13 is not capable of distinguishing one orientation of the horns of such an air cap from another orientation of the horns of an air cap. Further,

since the tool to which Jaccard's fork-shaped support 13 is to be attached presumably has a circular cross section, the opening in Jaccard's fork-shaped support 13 will not (and indeed is not intended to) so orient Jaccard's fork-shaped support 13 with respect to the horns of such an air cap that Jaccard's level will, in the words of claim 1, "indicat[e] when the horns received in the at least one first opening are in a first orientation." As a consequence of this inability of Jaccard's fork-shaped support 13 to orient Jaccard's fork-shaped support 13 with respect to the horns of such an air cap, it is not possible for Jaccard's level to, in the words of claim 9, "indicat[e] when the horns received in the at least one first opening are in a vertical orientation." Therefore, the 35 U. S. C. § 102(b) rejection of claim 9 based upon Jaccard is in error, and should be reversed.

#### Claim 10

Claim 10 recites a device for positioning an air cap of a pneumatically aided atomizer, the air cap having air horns extending therefrom, the device providing at least one first opening adapted to receive the horns and a first level for indicating when the horns received in the at least one first opening are in a horizontal orientation.

Again, Jaccard's level 12 is rotatably attached 17, 18 to Jaccard's fork-shaped support 13 ("The provision of the coupling consisting of the bore 17 of the support 13, and the expandible appendix 18 makes it possible the position of the body 14 of the level 12 to be varied according to as required by the user, so as to secure that the perfect centering of the air bubble is always visible." Jaccard, col. 2, lines 38-43). Therefore, the level 12 of Jaccard is not intended to indicate a particular orientation of Jaccard's handpiece 10, but rather, only to indicate a particular orientation of Jaccard's level 12. Again, if, for the sake of argument, the opening in Jaccard's fork-shaped support 13 could receive the horns of an air cap, it would be able to receive the horns in any number of orientations. As such, the opening in Jaccard's fork-shaped support 13 is not capable of distinguishing one orientation of the horns of such an air cap from another orientation of the horns of an air cap. Further, since the tool to which Jaccard's fork-shaped support 13 is to be attached presumably has a circular cross section, the opening in Jaccard's fork-shaped support 13 will not (and indeed is not intended to) so orient Jaccard's fork-shaped support 13 with respect to the horns of such an air cap that Jaccard's level will, in the words of claim 1, "indicat[e] when the horns received in the at least one first opening are in a first orientation." As a consequence of this inability of Jaccard's fork-shaped support 13 to orient Jaccard's fork-shaped support 13 with respect to the horns of such an air cap, it is not possible for Jaccard's level to, in the words of claim 10, "indicat[e]



when the horns received in the at least one first opening are in a horizontal orientation.” Therefore, the 35 U. S. C. § 102(b) rejection of claim 10 based upon Jaccard is in error, and should be reversed.

#### Claims 13, 16 and 17

Claim 13 recites a method of positioning an air cap of a pneumatically aided atomizer, the air cap having air horns extending therefrom, the method including providing a device having at least one first opening adapted to receive the horns and a first level for indicating when the horns received in the at least one first opening are in a first orientation.

Again, there is no disclosure or suggestion that the opening formed by the fork-shaped support 13 in Jaccard’s air-bubble level 12 are capable of receiving the horns of an air cap in any orientation. The fork-shaped support 13 of Jaccard’s air-bubble level 12 allows the level 12 to be snap-fitted onto the shank of a dental hand tool 10, as discussed in Jaccard. Thus, the opening created by the fork-shaped support 13 of Jaccard is not appropriately sized or “adapted to receive” the horns of an air cap as claimed in claim 13. Appellants cannot imagine any air cap, the horns of which the opening created by the fork-shaped support 13 of Jaccard is adapted to receive. Further, Jaccard provides no support, teaching, or suggestion that the opening created by the fork-shaped support 13 is capable of receiving or adapted to receive horns of an air cap.

Even assuming for the sake of argument, however, that the opening formed by the fork-shaped support 13 in Jaccard’s air-bubble level 12 would, in fact, be able to receive the horns of an air cap, that opening is C-shaped, and therefore would be able to receive the horns in any number of orientations. Indeed, the generally C-shaped opening formed by Jaccard’s fork-shaped support does not provide the user with any indication in which of an infinite number of possible orientations the horns of the air cap should be received. As such, the opening formed by Jaccard’s fork-shaped support 13 is not capable of distinguishing one orientation of the horns of such an air cap from another orientation of the horns of an air cap. Since the tool to which Jaccard’s fork-shaped support 13 is to be attached presumably has a circular cross section, the opening in Jaccard’s fork-shaped support 13 will not (and indeed is not intended to) so orient Jaccard’s fork-shaped support 13 with respect to the horns of such an air cap that Jaccard’s level will, in the words of claim 13, “indicat[e] when the horns received in the at least one first opening are in a first orientation.” Even further, Jaccard’s level 12 is rotatably attached 17, 18 to Jaccard’s fork-shaped support 13 (“The provision of the coupling consisting of the bore 17 of the support 13, and the expandible appendix 18

makes it possible the position of the body 14 of the level 12 to be varied according to as required by the user, so as to secure that the perfect centering of the air bubble is always visible.” Jaccard, col. 2, lines 38-43). Therefore, the level 12 of Jaccard is not intended to indicate a particular orientation of Jaccard’s handpiece 10, but rather, only to indicate a particular orientation of Jaccard’s level 12. Therefore, the 35 U. S. C. § 102(b) rejection of claim 13 based upon Jaccard is in error, and should be reversed.

Claims 16 and 17 stand or fall with claim 13.

#### Summary

Claim 1 specifically recites a “level for indicating when the horns received in the at least one first opening are in a first orientation.” Claim 9 specifically recites a “level for indicating when the horns received in the at least one first opening are in a vertical orientation.” Claim 10 specifically recites a “level for indicating when the horns received in the at least one first opening are in a horizontal orientation.” Claim 13 specifically recites, “a first level for indicating when the horns received in the at least one first opening are in a first orientation.” None of the above-quoted structural and functional language from the rejected claims appears anywhere in Jaccard. Accordingly, Appellants submit that the 35 U. S. C. § 102 rejection of claims 1, 4, 5, 9, 10, 13, 16, and 17 based upon Jaccard is erroneous, and should be reversed. Such action is respectfully requested.

Respectfully submitted,



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INDS02 CYS 716882

## CLAIMS APPENDIX

1. A device for positioning an air cap of a pneumatically aided atomizer, the air cap having air horns extending therefrom, the device providing at least one first opening adapted to receive the horns and a first level for indicating when the horns received in the at least one first opening are in a first orientation.

4. The device of claim 1 including a first surface extending generally in a first direction when the horns are received in the at least one first opening and a second surface extending generally in a second direction opposite the first direction when the horns are received in the at least one first opening.

5. The device of claim 4 wherein the at least one first opening extends through the device from the first surface to the second surface.

9. The device of claim 1 wherein the first level for indicating when the horns received in the at least one first opening are in the first orientation is a first level for indicating when the horns received in the at least one first opening are in a vertical orientation.

10. The device of claim 1 wherein the first level for indicating when the horns received in the at least one first opening are in the first orientation is a first level for indicating when the horns received in the at least one first opening are in a horizontal orientation.

13. A method of positioning an air cap of a pneumatically aided atomizer, the air cap having air horns extending therefrom, the method including providing a device having at least one first opening adapted to receive the horns and a first level for indicating when the horns received in the at least one first opening are in a first orientation.

16. The method of claim 13 wherein providing a device having at least one first opening adapted to receive the horns and a first level for indicating when the horns received in the at least one first opening are in a first orientation includes providing a device having a first surface extending generally in a first direction when the horns are received in the at least one first opening and a second surface extending generally in a second direction opposite the first direction when the horns are received in the at least one first opening.

17. The method of claim 16 wherein providing a device having at least one first opening, a first surface extending generally in a first direction when the horns are received in the at least one first opening and a second surface extending generally in a second direction opposite the first direction when the horns are received in the at least one first opening together include providing at least one first opening which extends through the

device from the first surface to the second surface.

## EVIDENCE APPENDIX

The Examiner attached a copy of Jaccard's Figs. 1-3 to the December 16, 2004 official action being appealed. The Examiner made certain notations to Jaccard's Fig. 2 concerning the Examiner's interpretation of Jaccard in the December 16, 2004 official action. A copy of that evidence appears on the following page.

Fig. 1

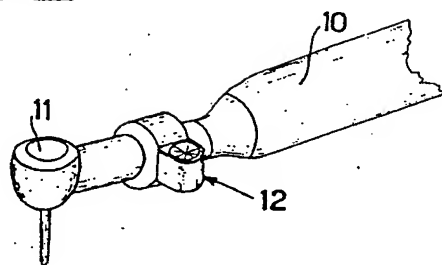


Fig. 2

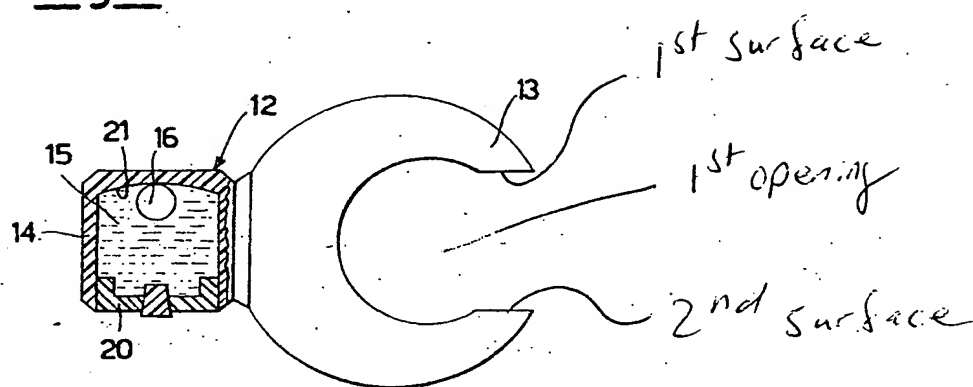
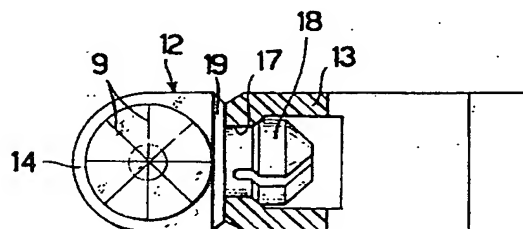


Fig. 3



RELATED PROCEEDINGS APPENDIX

There are no other proceedings related to this appeal.